



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*zel*

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/718,683      | 11/24/2003  | Francis Pruche       | 05725.1256-00       | 3211             |

22852 7590 08/09/2007  
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

MAIL DATE DELIVERY MODE

08/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/718,683

Applicant(s)

PRUCHE ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-69 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The examiner of this application is changed from Royds Leslie to Jyothsna Venkat.

Receipt is acknowledged of election filed on 5/9/07. Upon further review of the claims, restriction requirement is modified. **Applicants are notified that the restriction between the species dated 4/13/07 remains the same.**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-57, 66 and 68-69 are, drawn to a coloring composition for a keratin material, a cosmetic skin product, a hair color product and a cosmetic product for nails, eyelashes and/or eyebrows, classified in class 434, subclasses 401, 61, 70.6 and 70.7.
- II. Claims 58-59 and 62-63 are, drawn to

Art Unit: 1615

58. A process for coloring a keratin material, comprising
- applying to the keratin material, in the presence of oxygen,
    - at least one coloring agent component comprising, in a physiologically acceptable medium,
      - at least one dye precursor chosen from compounds comprising at least one aromatic ring comprising at least two hydroxyl groups borne by two successive carbon atoms of the at least one aromatic ring, and
      - at least one catalytic system comprising at least one first catalyst (1) chosen from Mn(II) and Zn(II) salts and oxides and at least one second catalyst (2) chosen from alkali metal hydrogen carbonates and alkaline-earth metal hydrogen carbonates;
        - wherein the catalysts (1) and (2) are present with the at least one dye precursor in a single composition (A),
    - developing the color to obtain a desired shade,
    - applying at least one component (B) comprising at least one acidic composition to the keratin material to fix the shade;
    - optionally applying at least one component (C) comprising at least one alkaline composition to the keratin material to increase the intensity of the color or to modify the shade; and
    - optionally fixing the new color or shade obtained by applying a new application of at least one component (B) comprising at least one acidic composition to the keratin material.

classified in class 424, subclass 70.6.

III. Claims 60-61 and 64-65 are, drawn to

Art Unit: 1615

60. A process for coloring a keratin material, comprising:

- applying to the keratin material at least one component (A<sub>1</sub>) comprising, in a physiologically acceptable medium,

- at least one dye precursor chosen from compounds comprising at least one aromatic ring comprising at least two hydroxyl groups borne by two successive carbon atoms of the at least one aromatic ring and

- at least one catalyst system comprising either at least one first catalyst (1) chosen from Mn(II) and Zn(II) salts and oxides or at least one second catalyst (2) chosen from alkali metal hydrogen carbonates and alkaline-earth metal hydrogen carbonates;

- revealing the color in the presence of oxygen by applying at least one component (A<sub>2</sub>) comprising the other of the at least one first catalyst (1) and the at least one second catalyst (2) not present in the at least one component (A<sub>1</sub>),

- developing the color to obtain the desired shade,

- applying at least one component (B) comprising at least one acidic composition to the keratin material to fix the shade;

- optionally applying at least one component (C) comprising at least one alkaline composition to the keratin material to increase the intensity of the color or to modify the shade; and

- optionally fixing the new color or shade obtained by applying a new application of at least one component (B) comprising at least one acidic composition to the keratin material.

classified in class 424, subclass 70.6.

IV. Claim 67 is, drawn to

Art Unit: 1615

67. A method for artificially tanning and/or browning the skin, and/or for giving a healthy complexion comprising

- applying to the skin at least one coloring composition comprising
- (i) at least one coloring agent component comprising, in a physiologically acceptable medium,
  - at least one dye precursor chosen from compounds comprising at least one aromatic ring comprising at least two hydroxyl groups borne by two successive carbon atoms of the at least one aromatic ring, and

- at least one catalytic system comprising at least one first catalyst (1) chosen from Mn(II) and Zn(II) salts and oxides and at least one second catalyst (2) chosen from alkali metal hydrogen carbonates and alkaline-earth metal hydrogen carbonates;

wherein the catalysts (1) and (2) are present with the at least one dye precursor in a single composition (A) or separated into two components (A<sub>1</sub>) and (A<sub>2</sub>) wherein the at least one dye precursor is present in at least one of the components (A<sub>1</sub>) and (A<sub>2</sub>);

and at least one component chosen from:

- (ii) a component (B) comprising at least one acidic composition, and
- (iii) a component (C) comprising at least one alkaline composition,

wherein at least two of the at least one coloring agent component, the component (B) and the component (C) are present in the coloring composition in an amount effective for artificially tanning and/or browning the skin, and/or for giving a healthy complexion.

, classified in class 424, subclass 59.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1615

Inventions I and (II-III) and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the composition is used for coloring hair and also artificially tanning the skin or giving a healthy complexion evidenced by applicants.

Inventions I and II are directed to related distinct and separate method of uses. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are mutually exclusive. Note that in group II the catalysts (1) and (2) are present in single composition with the dye precursor, where as in group III they are not present in single composition with the dye precursor. It is a serious search burden to examine both the groups since art anticipating group II would not anticipate group III. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions II or III and IV are directed to related distinct processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed

Art Unit: 1615

have different modes of operation and effect. Groups II and III are related to coloring hair, where as group IV is drawn to providing healthy complexion to the skin or tanning the skin.

Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully

Art Unit: 1615

examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number or the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/718,683

Page 11

Art Unit: 1615

A handwritten signature in black ink, appearing to read "J. Venkat".

**JYOTHSNA A VENKAT Ph. D**

**Primary Examiner**

**Art Unit 1615**

\*\*\*